

REMARKS

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2 The Applicant has received and reviewed the Final Office Action dated 12
3 September 2005 (the "Final Action"), and submits this paper as a fully-responsive
4 reply thereto. This response is submitted with a Request for Continued
5 Examination (RCE) filed in this matter. The Applicant respectfully requests
6 reconsideration of this Application based on the above claim amendments and the
7 following remarks.

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9 A review of the claims indicates that:

10 Claims 1-20 were originally submitted.

11 Claims 1, 8, 16, 18, and 20 are currently amended.

12 Claims 2-7, 9-15, and 17 are cancelled herein.

13
14 As stated on Paragraph 2 on Page 2 of the Final Action, claims 1-3 and 7-
15 13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent
16 No. 5,086,674 to Her ("Her"), in view of U.S. Patent No. 4,357,845 to Cornia
17 ("Cornia"). The Applicant respectfully traverses these rejections.

18 Turning to **independent claim 1**, only to advance prosecution of this case,
19 and without conceding the propriety of the stated rejections, and without
20 conceding that the cited art provides the teachings for which it is cited in the Final
21 Action, the Applicant has amended claim 1 as indicated above to clarify further
22 features of the hand tool. For convenience, the Applicant reproduces claim 1 as
23 revised above, with redlines included, and with emphasis added for ease of
24 discussion:
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1 “1. (**Currently Amended**) A one piece multi-purpose hand tool, comprising:
2 a socket body having a socket at a first end, wherein the socket defines an opening for
3 receiving a second tool;
4 a plastic sheathing around the socket body;
5 a hex key tip; and
6 an arm portion connected between a second end of the socket body and the key tip,
7 wherein the arm portion defines an opening to receive a torque arm device, wherein the opening
8 extends partially through the arm portion,
9 *wherein the socket body, the key tip, and the arm portion are of one piece, unitary*
10 *construction, wherein the key tip defines a notch in an end of the key tip opposite the arm portion,*
11 and wherein the tool includes a material selected from the group consisting of metal, metal alloys,
12 steel and steel alloys.”

13 The revisions to claim 1 are believed fully supported under 35 U.S.C.
14 § 112, 1st paragraph, at least because claim 1 is amended to incorporate features
15 formerly recited severally in dependent claims 2-7, all of which depended directly
16 from claim 1.

17 Turning to the cited art, Her pertains generally to a multi-purpose hand tool.
18 In its Figure 1, Her illustrates hexical bar member 50, screwdriver bit 60, and
19 wrench member 70, all of which may be selectively engaged in, for example,
20 connecting block 30. The Applicant submits that Her does not disclose a socket
21 body, key tip, and arm portion having a one piece, unitary construction, as recited
22 and emphasized above in the Applicant's claim 1. The Applicant thus agrees with
23 the assessment on Page 2 of the Final Action that Her does not disclose the device
24 being of one piece, unitary construction.
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1 Because of Her's shortcomings, the Final Action cited Cornia as providing
2 a socket hand tool being of one piece, unitary construction, and stated that it would
3 have been obvious to modify Her in view of Cornia to provide a hand tool of one
4 piece, unitary construction. However, the Applicant submits that the modification
5 of Her as proposed in the Final Action is improper under § 103, because it would
6 frustrate at least one of the stated purposes of the Her device. Namely, Her's
7 Abstract provides as follows:

8
9 *integrally at both ends, to which a pair of connecting*
10 *blocks or heads are mounted. The connecting blocks*
11 *has a plurality of through holes, of hexical shape, to*
12 *substantially receive, as desired, screw driver bits,*
wrench member, etc., so that it is particularly suitable
for various type and different sizes of screws. In addi-

13 Modifying Her to be a one-piece, unitary device as proposed in the Final
14 Action would frustrate Her's stated purpose of providing a multi-purpose tool that
15 is particularly suitable for various types and sizes of screws. Modifying Her as
16 proposed in the Final Action would result in a single-purpose tool, which is
17 directly contrary to Her's stated objective of providing a multi-purpose tool.

18 On at least this basis, the Applicant submits that Her provides no
19 suggestion or motivation to look to Cornia, or elsewhere, to provide a one-piece,
20 unitary device. The Applicant submits that Her and Cornia do not support a § 103
21 rejection of claim 1, and requests reconsideration and withdrawal of the § 103
22 rejection of claim 1 as stated in Paragraph 2 of the Final Action.

23 Claims 2-7 are cancelled only to advance prosecution of this case, and
24 without waiver, prejudice, or disclaimer of the subject matter recited therein.
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1 As stated in Paragraph 3 on Page 2 of the Final Action, claims 1-2 and 7-12
2 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Her in view of
3 U.S. Patent No. 4,399,723 to Marleau ("Marleau"). The Applicant respectfully
4 traverses these rejections.

5 The Applicant discussed Her above, and in the interests of conciseness,
6 those comments are only summarized here. Her fails to teach or suggest a tool
7 "wherein the socket body, the key tip, and the arm portion are of one piece, unitary
8 construction", as recited in the Applicant's claim 1. Marleau pertains to a compact
9 combination tool set, and is cited in the Final Action as teaching a tool being of
10 one piece, unitary construction. Without conceding that Marleau provides such
11 teaching, the Applicant submits that Her provides no suggestion or teaching to
12 modify its tool to be of one piece, unitary construction, at least for the reasons set
13 forth above. Put differently, the modification of Her as proposed in Paragraph 3 of
14 the Final Action would frustrate at least one of the stated purposes of the Her tool,
15 and is therefore improper under § 103.

16 Based at least on the foregoing revisions and comments, the Applicant
17 submits that Her and Marleau do not support a § 103 rejection of claim 1, and
18 requests reconsideration and withdrawal of the § 103 rejection of claim 1 as stated
19 in Paragraph 3 of the Final Action.

20 Turning to **independent claim 8**, only to advance prosecution of this case,
21 and without conceding the propriety of the stated rejections, and without
22 conceding that the cited art provides the teachings for which it is cited in the Final
23 Action, the Applicant has amended claim 8 to clarify further features of the hand
24 tool. These features were formerly recited in claims 9-15, and are supported under
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1 § 112, 1st paragraph, on at least this basis. Claims 9-15 are cancelled without
2 waiver, prejudice, or disclaimer of the subject matter recited therein.

3 In addition, the Applicant reproduces the following feature recited in claim
4 8 for convenience of discussion, with emphasis added:

5 “wherein the means for torquing, the means for socket wrenching, and the arm portion
6 are of *one piece, unitary construction*.”

7 The Applicant submits that the above comments directed to Her and Cornia
8 or Marleau apply equally to claim 8. On at least this basis, the Applicant submits
9 that Her and Cornia or Marleau fail to support a § 103 rejection of claim 8. The
10 Applicant thus requests reconsideration and withdrawal of the § 103 rejection of
11 claim 8 as stated in Paragraphs 1 and 2 of the Final Action.

12 Turning to **dependent claim 4**, paragraph 4 on Page 3 of the Final Action
13 stated a rejection of claim 4 as being unpatentable over Her and either Cornia or
14 Marleau, further in view of U.S. Patent No. 1,463,822 to Ittel (“Ittel”). As noted
15 above, claim 4 was cancelled without waiver, prejudice, or disclaimer of the
16 subject matter recited therein, and the features formerly recited therein are now
17 recited in claim 1. The Applicant further submits that Ittel does not provide the
18 teaching or suggestion missing from Her and either Cornia or Marleau necessary
19 to support a § 103 rejection of claim 1.

20 Turning to **dependent claim 5**, paragraph 5 on Page 3 of the Final Action
21 stated a rejection of claim 5 as being unpatentable over Her and either Cornia or
22 Marleau, further in view of U.S. Patent No. 5,216,940 to Hedden (“Hedden”). As
23 noted above, claim 5 was cancelled without waiver, prejudice, or disclaimer of the
24 subject matter recited therein, and the features formerly recited therein are now
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1 recited in claim 1. The Applicant further submits that Hedden does not provide
2 the teaching or suggestion missing from Her and either Cornia or Marleau
3 necessary to support a § 103 rejection of claim 1.

4 Turning to **dependent claim 6**, paragraph 6 on Page 4 of the Final Action
5 stated a rejection of claim 6 as being unpatentable over Her and either Cornia or
6 Marleau, further in view of U.S. Patent No. 4,947,713 to Arnold ("Arnold"). As
7 noted above, claim 6 was cancelled without waiver, prejudice, or disclaimer of the
8 subject matter recited therein, and the features formerly recited therein are now
9 recited in claim 1. The Applicant further submits that Arnold does not provide the
10 teaching or suggestion missing from Her and either Cornia or Marleau necessary
11 to support a § 103 rejection of claim 1.

12 Turning to **dependent claim 14**, paragraph 7 on Page 4 of the Final Action
13 stated a rejection of claim 14 as being unpatentable over Her and either Cornia or
14 Marleau, further in view of Ittel. As noted above, claim 14 was cancelled without
15 waiver, prejudice, or disclaimer of the subject matter recited therein, and the
16 features formerly recited therein are now recited in claim 8. The Applicant further
17 submits that Ittel does not provide the teaching or suggestion missing from Her
18 and either Cornia or Marleau necessary to support a § 103 rejection of claim 8.

19 Turning to **dependent claim 15**, paragraph 8 on Page 4 of the Final Action
20 stated a rejection of claim 15 as being unpatentable over Her, Cornia, and Ittel,
21 further in view of Arnold. As noted above, claim 15 was cancelled without
22 waiver, prejudice, or disclaimer of the subject matter recited therein, and the
23 features formerly recited therein are now recited in claim 8. The Applicant further
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1 submits that Arnold does not provide the teaching or suggestion missing from Her,
2 Cornia, and Ittel necessary to support a § 103 rejection of claim 8.

3 As stated in Paragraph 9 on Page 4 of the Final Action, claims 16-18 stand
4 rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No.
5 4,620,460 to Gonzales, Jr. ("Gonzales"), in view of Her. The Applicant
6 respectfully traverses these rejections.

7 Turning to **independent claim 16**, only to advance prosecution of this case,
8 and without conceding the propriety of the stated rejections, and without
9 conceding that the cited art provides the teachings for which it is cited in the Final
10 Action, the Applicant has amended claim 16 as indicated above to clarify further
11 features of the set of tools.

12 For convenience of discussion, the Applicant reproduces here a portion of
13 claim 16, with emphasis added:

14 "at least a second tool that is *identical* to the first tool"

15 The Applicant submits that the foregoing feature is fully supported under § 112, 1st
16 paragraph, at least by the Applicant's Figure 5 and related description appearing in
17 Paragraph [0017] of the Applicant's specification.

18 Turning to the cited art, Gonzales pertains generally to a socket set in which
19 the various socket members 10 may be engaged with one another. However,
20 Gonzales' Figure 4 indicates that the various sockets members 10 are of different
21 sizes. When a plurality of Gonzales' socket members 10 are engaged with one
22 another, the assembled sockets take on a telescoping configuration, as shown in
23 Gonzales' Figure 4.

1 In contrast to Gonzales, the Applicant's claim 16 recites "a second tool that is
2 identical to the first tool", resulting in the non-telescoping configuration shown in the
3 Applicant's Figure 5. The telescoping configuration shown by Gonzales neither
4 teaches nor suggests "a second tool that is identical to the first tool", as recited in the
5 Applicant's claim 16. On at least this basis, Gonzales does not support a § 103
6 rejection of claim 16.

7 Turning to Her, the Applicant has discussed Her above, and in the interests of
8 conciseness, those comments are not repeated here. The Applicant submits that Her
9 fails to provide the teaching or suggestion missing from Gonzales that is necessary to
10 support a § 103 rejection of claim 16. On at least this basis, the Applicant submits
11 that Gonzales and Her fail to support a § 103 rejection of claim 16. The Applicant
12 thus requests reconsideration and withdrawal of the § 103 rejection of claim 16 as
13 stated in Paragraph 9.

14 Claim 17 is cancelled without waiver, prejudice, or disclaimer of the subject
15 matter recited therein. Claims 18 depends now from claim 16, so the comments
16 directed above to claim 16 apply equally to claim 18. The Applicant thus requests
17 reconsideration and withdrawal of the § 103 rejection of claim 18 as stated in
18 Paragraph 9.

19 As stated in Paragraph 10 on Page 5 of the Final Action, claims 16-19 stand
20 rejected under 35 U.S.C. §103(a) as being unpatentable over Marleau, in view of
21 Her. The Applicant respectfully traverses these rejections.

22 Turning once again to **independent claim 16**, only to advance prosecution
23 of this case, and without conceding the propriety of the stated rejections, and
24 without conceding that the cited art provides the teachings for which it is cited in
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1 the Final Action, the Applicant has amended claim 16 as indicated above to clarify
2 further features of the set of tools.

3 For convenience of discussion, the Applicant reproduces here portions of
4 claim 16, with emphasis added:

5 “wherein the first socket body, the first key tip, and the first arm portion of the first tool
6 are of *one piece, unitary construction*;

7 wherein the second socket body, the second key tip, and the second arm portion of the
8 second tool are of *one piece, unitary construction*,”

9 For at least the reasons discussed above, the Applicant submits that neither
10 Marleau nor Her discloses a tool having a socket body, a key tip, and an arm
11 portion being of one piece, unitary construction, as recited in claim 16. On at least
12 this basis, Marleau and/or Her do not support a § 103 rejection of claim 16. The
13 Applicant thus requests reconsideration and withdrawal of the § 103 rejection of
14 claim 16 as stated in Paragraph 10 of the Final Action.

15 Paragraph 11 on Page 5 of the Final Action stated a § 103 rejection of **claim**
16 **20** as being unpatentable over Marleau and Her, further in view of Ittel. Claim 20
17 depends ultimately from claim 16, which was discussed above. The comments
18 directed above to claim 16 apply equally to claim 20. In addition, the Applicant
19 submits that Ittel does not provide the teaching or suggestion missing from
20 Marleau and Her necessary to support a § 103 rejection of claim 16.

21 **Conclusion**

22 The Applicant requests favorable action on this matter at the earliest
23 convenience of the Office. If personal discussion would advance prosecution of
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1 this matter, the Office is invited to contact the undersigned to schedule a telephone
2 interview.

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4 Respectfully Submitted,

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6 Dated: 13 FEB 06

By: 

Rocco L. Adornato
Reg. No. 40,480
Attorney for Applicant

LEE & HAYES PLLC
Suite 500
421 W. Riverside Avenue
Spokane, Washington 99201
Telephone: 509-324-9256 x257
Facsimile: (509) 323-8979